

REMARKS

The last Office Action has been carefully considered.

It is noted that claims 1, 4, 7, and 12 are rejected under 35 U.S.C. 102(e) over the U.S. patent to Dolker.

Claims 1-4, 7-12, 14 and 15 are rejected under 35 U.S.C. 103(a) over the U.S. patent to Kojima in view of the U.S. patent to Weiss and Kolmanovsky.

Claim 6 is rejected under 35 U.S.C. 103 over the U.S. patent to Kojima in view of the U.S. patents to Weiss and Sieber.

Also, the drawings are objected to and the claims are rejected under 35 U.S.C. 112.

In connection with the Examiner's formal objection to the drawings and rejection of the claims under 35 U.S.C. 112, applicants submitted a copy of the drawings with corresponding labeling of the boxes in the drawings which specify the corresponding steps of the inventive method and structural elements of the device. It is believed that the Examiner's grounds for the objection to the

drawings and rejection of the claims should be considered as not tenable and should be withdrawn.

After carefully considering the Examiner's grounds for the rejection of the claims over the art, applicants amended claims 1 and 9 to define in these claims additional features of the inventive device for controlling an internal combustion engine and the inventive method for controlling an internal combustion engine.

Claim 1, the broadest apparatus claim in addition to the original features, defines that the calculating means, in an engine with a control selected from the group consisting of a variable valve control and a compression control, control parameters for the variable valve control or for the compression control are defined such that the runup to engine operating speed follows the specific starting energy.

Claim 9, the broadest method claim, in addition to other method steps defines that in an engine with a variable valve control for a compression control, control parameters for the variable valve control or the compression control are defined such that the runup to engine operating speed follows the specified starting strategy.

Turning now to the references applied by the Examiner and in particular to the U.S. patent to Dolker, it can be seen that this reference does not teach the above mentioned new features of the present invention as now defined in claims 1 and 9. The original claims were rejected over this reference as being anticipated.

In connection with this, it is believed to be advisable to cite the decision in *re Lindenman Maschinenfabrik GmbH v. American Hoist & Derrick Co.*, 221 USPQ 481, 485 (Fed. Cir. 1984) in which it was stated:

"Anticipation requires the presence in a single prior art reference disclosure of each and every element of the claimed invention, arranged as in the claim."

Definitely, the patent to Dolker does not disclose each and every element of the present invention as now defined in claims 1 and 9.

Therefore the rejection of the original claims over this reference as being anticipated should be considered as not tenable and should be withdrawn.

The patents to Kojima, Weiss, Kolmanovsky, and Sieber were applied by the Examiner in different combinations against some original claims. None of the references teaches the new features of the present invention which

are now defined in amended claims 1 and 9. Therefore, the combinations applied by the Examiner against the original claims would not lead to the applicant's invention as defined in the amended claims 1 and 9. In order to arrive at the applicant's invention from the teachings of the references, it is not sufficient just to planely combine them, but it would necessary to modify them by including into them the new features which are not disclosed in the references. However, it is known that in order to arrive at a claimed invention, by modifying the references the cited art must itself contain a suggestion for such a modifcation.

This principle has been consistently upheld by the U.S. Court of Customs and Patent Appeals which, for example, held in its decision in re Randol and Redford (165 USPQ 586) that

Prior patents are references only for what they clearly disclose or suggest, it is not a proper use of a patent as a reference to modify its structure to one which prior art references do not suggest.

It is therefore believed to be clear that claims 1 and 9 should be considered as patentably distinguishing over the art and should be allowed.

As for the dependent claims, applicants canceled claims 13 and 14 without prejudice, since their features were introduced into claims 1 and 9.

Retained claims 2-8 depend on the amended claim 1 and retained claims 10-12 and 15 depend on the amended claim 9. Since they share their allowable features of amended claims 1 and 9, it is respectfully submitted that they should be allowed as well.

Reconsideration and allowance of the present application is most respectfully requested.

Should the Examiner require or consider it advisable that the specification, claims and/or drawings be further amended or corrected in formal respects in order to place this case in condition for final allowance, then it is respectfully requested that such amendments or corrections be carried out by Examiner's Amendment, and the case be passed to issue. Alternatively, should the Examiner feel that a personal discussion might be helpful in advancing this case to allowance; he is invited to telephone the undersigned (at 631-549-4700).

Respectfully submitted,

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